

REMARKS

Claims 16-25 are pending in this application. By this Amendment, claims 18 and 21 are amended to address objections to these claims. No new matter is added.

Entry of the amendments is proper under 37 CFR §1.116 since the amendments: (a) place the application in condition for allowance (for the reasons discussed herein); (b) do not raise any new issue requiring further search and/or consideration; (c) satisfy a requirement of form asserted in the previous Office Action; and (d) place the application in better form for appeal, should an appeal be necessary. The amendments are necessary and were not earlier presented because they are made in response to claim objections raised in the final rejection. Entry of the amendments is thus respectfully requested.

Reconsideration of the application is respectfully requested.

Informalities

Claims 18 and 21 were objected to for allegedly containing errors. Claims 18 and 21 are amended to overcome the objection. As such, reconsideration and withdrawal of the objections are respectfully requested.

Rejections Under 35 U.S.C. §103(a)

Claims 16-19 were rejected under 35 U.S.C. §103(a) for allegedly being unpatentable over U.S. Patent No. 6,542,253 ("Kim") in view of U.S. Patent No. 6,084,934 ("Garcia"), further in view of U.S. Patent No. 6,742,130 ("Kawase"); claim 20 was rejected under 35 U.S.C. §103(a) for allegedly being unpatentable over Kim in view of Garcia, further in view of Kawase and U.S. Patent No. 6,977,945 ("Noda"); claims 22-23 were rejected under 35 U.S.C. §103(a) as allegedly being unpatentable over Kim in view of Garcia, further in view of Kawase and allegedly commonly known prior art at the time of the invention; and claims 21, 24 and 25 were rejected under 35 U.S.C. §103(a) as allegedly being unpatentable over Kim in view of Garcia, further in view of Kawase, and further in view of Noda and allegedly

commonly known prior art at the time of the invention. Applicants respectfully traverse these rejections.

None of the applied references, alone or in combination, teach or suggest an image forming apparatus having a power save mode and a normal mode, the image forming apparatus including a controller configured to be in the off-state in the power saving mode and to control the image forming portion to output the received data after a period of transition from the power saving mode to the normal mode, as recited in independent claim 16. The Office Action asserts that Kim teaches this feature, Applicants respectfully disagree.

Kim merely teaches that a controller unit decodes print data transmitted from a host computer and controls a print operation. (See column 1, lines 44-46). The controller unit in Kim does not control an image-forming portion that outputs received data after a period of transition from a power saving mode to a normal mode. In fact, the Office Action concedes that Kim does not disclose a power saving mode and relies on Kawase for teaching this feature. However, the combination of Kawase and Kim fails to teach or suggest that a controller is in an off-mode during a power save mode, and that the controller controls an image forming portion that outputs received data after a period of transition from a power saving mode to a normal mode.

Further, none of the references, alone or in combination, teach or suggest a communication interface that includes a receiver, and is configured to control a speed for receiving data during the period of transition from the power save mode to the normal mode, as recited in claim 16. The Office Action asserts that Garcia teaches this feature. Applicants respectfully disagree.

Garcia merely teaches a data transmission system capable of automatically adjusting a data transfer rate of a sender to a receiver. Nowhere does Garcia make mention of controlling

a speed of receiving data during a period of transition from power save mode to normal mode, as required in claim 16. Garcia, in fact, does not relate to printers at all.

It appears as though the Patent Office is relying on Kim for teaching a controller, Kawase for teaching a power save mode and Garcia for teaching controlling the rate at which data is received. While each of these features do exist in claim 16, the combination of these references fail to teach or suggest every claimed feature. MPEP §2106 (II)(C) recites, "when evaluating the scope of a claim, every limitation in the claim must be considered. USPTO personnel may not dissect a claimed invention into discrete elements and then evaluate the elements in isolation. Instead, the claim as a whole must be considered." In the present rejections, it is evident that the Patent Office is improperly picking and choosing various elements of the claims from the prior art in hindsight, and ignoring the requirements recited in the present claims with respect to how the elements interact.

The combination of Kim, Garcia and Kawase fail to disclose a controller configured to be in the off-state in a power saving mode and to control the image forming portion to output received data after a period of transition from the power saving mode to the normal mode, and a communication interface that includes a receiver, and configured to control a speed for receiving data during the period of transition, as recited in claim 16.

Further, Noda teaches a data transmission system and a network interface for controlling a transfer rate in response to notices informing that reception is normally completed or not normally completed. However, Noda fails to cure deficiencies in Kim, Garcia and Kawase in disclosing or rendering obvious the features of independent claim 16.

Furthermore, the allegedly commonly known prior art fails to cure the above-detailed deficiencies in Kim, Garcia and Kawase in disclosing or rendering obvious the features of independent claim 16.

For at least these reasons, independent claim 16, and its dependent claims, are patentable over the applied references. Thus, withdrawal of the rejection of claims under 35 U.S.C §103(a) is respectfully requested.

Conclusion

In view of the foregoing, it is respectfully submitted that this application is in condition for allowance. Favorable reconsideration and prompt allowance of claims 16-25 are earnestly solicited.

Should the Examiner believe that anything further would be desirable in order to place this application in even better condition for allowance, the Examiner is invited to contact the undersigned at the telephone number set forth below.

Respectfully submitted,



James A. Oliff
Registration No. 27,075

Kevin K. Jones
Registration No. 56,809

JAO:KKJ/hs

Date: April 20, 2007

OLIFF & BERRIDGE, PLC
P.O. Box 19928
Alexandria, Virginia 22320
Telephone: (703) 836-6400

<p>DEPOSIT ACCOUNT USE AUTHORIZATION Please grant any extension necessary for entry; Charge any fee due to our Deposit Account No. 15-0461</p>
--